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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,460	06/11/2002	Francis Pruche	2365-35	3379

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EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,460

Applicant(s)

PRUCHE ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgment is made of the amendment filed 12/29/03. Claims pending are 1-16.

Claims 1, 4 and 6 have been amended. Claims 12-16 are new.

Claim Objections

1. Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 16 does not further limit the subject matter of Claim 14 because it recites the same limitations as are recited in Claim 14, i.e. "caring for, making up or coloring".

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 as amended introduces new matter as it uses the phrase "said treating being viewed on a support other than said localized area prior to said applying". The Applicant did not point out and the Examiner was unable to find support in the specification for the employment of said limitation in the claim. The limitation "said treating being viewed on a

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support other than said localized area” was not described in the application as filed, and persons skilled in the art would not recognize in the applicant’s disclosure a description of the invention as presently claimed. The specification discloses viewing the desired make-up design or coloration on the computer screen prior to applying design or coloration to a part of the body. See p. 9. However, the limitation “treating at least a part of the human body” is much broader than the disclosed “making-up” or “coloring”. Further, the limitation “support other than said localized area” is much broader than the disclosed computer screen. Therefore, it is the examiner’s position that the disclosure does not reasonably convey that the inventor has possession of the subject matter of the amendment at the time of filing of the instant application.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and those dependent thereon are viewed as indefinite because they recite the limitation “said treating being viewed on a support other than said localized area prior to said applying”. It is unclear what said limitation means: the treatment products are being viewed or the expected result of the treatment is being viewed before the application. Also see the new matter rejection above.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 6 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Soares et al. (US 5,612,044).

Soares et al. teach a method for imparting a tan to the human skin, said method comprising dispensing equal amounts of DHA composition and amino acid composition from their respective compartments of the multi-compartment container onto the human skin, mixing the phases together and rubbing the resulting mixture into skin. See Abstract; col. 8, lines 31-36. With respect to Claim 6, both compositions contain over 10 wt% of at least one solvent such as water. See col. 8, Example 2. With respect to Claim 1, the limitation “by applying at least two treatment products ...to a localized area...as a function of characteristics of the localized area and/or of a predetermined design”, it is being interpreted as follows: either the ingredients of the treatment products, or amounts of the ingredients, or amount of the treatment product or a pattern of application depend on the characteristics of the localized area of the body and/or on a predetermined design. The method of Soares et al. utilizes ingredients that impart tan of a natural hue and are safe to use on the human skin. See col. 2, lines 6-13.

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With respect to the limitation “said treating being viewed on a support other than said localized area prior to said applying”, the formulation of Soares et al. can be viewed in the container prior to the applying on the skin.

Thus, Soares et al. teach each and every limitations of Claims 1, 6 and 12.

8. Claims 1, 2, 5 and 7-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Weber et al. (US 6,341,831).

Weber et al. teach skin decoration apparatus and method of decorating human skin by applying on the skin multicolored designs using ink jet printing technology. See Abstract; Figures. Multiple biocompatible inks or dyes are carried from their respective reservoirs and sprayed onto the skin from multiple electronically controlled nozzles, thus allowing a predetermined image or pattern to be placed on any part of the human body. See Abstract; col. 6, lines 32-48; col. 7, lines 1-11; Claims 7, 9. Weber et al. teach using rapid-drying inks in a volatile solvent. See col. 6, line 59. Water-soluble inks may be used for making test decorations which can be evaluated and washed-off. See col. 6, lines 44-46. Weber et al. teach using Wirejet™ technology. See col. 2, lines 48-56. With respect to the limitation “said treating being viewed on a support other than said localized area prior to said applying”, the designs of Weber et al. can be stored in an electronic control system, viewed and selected by the user prior to the application. See col. 7, lines 5-11; Claim 9.

Thus, Weber et al. teach each and every limitation of Claims 1, 2, 5 and 7-16.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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10. Claims 3, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al.

Weber et al. applied as above. With respect to Claims 3 and 4, Weber et al. teach using Wirejet™ technology which has certain advantages over other ink jet technologies. See col. 2, lines 48-56. However, a drawback of the Wirejet™ technology is that it has limited resolution of 500 dpi. See col. 2, lines 56-60. Weber et al. also describes other conventional inkjet technologies such as thermal technology and piezoelectric technology. See col. 1, line 56 – col. 2, line 35. The advantages of the thermal technology include enhanced resolution up to 1200 dpi. See col. 2, lines 12-15. The advantages of piezo method include better control over the shape and size of ink droplet release and enhanced resolution up to 1600 dpi. See col. 2, lines 25-37. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Weber et al. such that to use either thermal or piezo method. One having ordinary skill in the art would have been motivated to do this to obtain enhanced resolution as suggested by Weber et al. above. With respect to Claim 6, the reference does not explicitly teach the claimed concentration of at least one solvent. However, the determination of optimal or workable concentration of the solvent by routine experimentation is obvious absent showing of criticality of the claimed concentration. One having ordinary skill in the art would have been motivated to do this to obtain the desired intensity of the ink and/or rheology of the ink composition.

11. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soares et al.

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Suares et al. teach a method for imparting a tan coloration to the human skin as discussed above. The reference does not explicitly teach the step of viewing a chosen coloration before the product is applied. However, it is known in the art of artificial tanning compositions to apply a tanning product to a small area of the skin first to determine whether the coloration will satisfy the expectations of the user and/or whether the user is allergic to said tanning product. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Suares et al. such that to view the coloration prior to applying the product. One having ordinary skill in the art would have been motivated to do this to avoid disappointing results such as unnatural skin tone, and to avoid allergic reaction to the product.

Response to Arguments

12. Applicant's arguments filed 12/29/03 have been fully considered but they are not persuasive.

13. The Applicant argues that in the Suares et al. patent “a constant combination of constant substances is applied” and, therefore, “there is no adaptation as a function of characteristics of a localized area or of a predetermined design”. See p. 8 of the Remarks. In response, it is noted that the amount the 2-part composition of Suares et al. applied to the skin is inherently “a function of characteristics of the localized area” such as size of the area. For example, the amount of the composition applied to the face will be “adapted” to cover the face and will normally be smaller than the amount applied to the legs because the area of the face is smaller than that of the leg. In this example, the size of the area is a characteristic of the area and, therefore, meets the claim limitation. Further, the Applicant argues that in the Suares et

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al. patent the “combination of the substances is not made directly on the skin but before it reaches the skin”. In response, the reference teaches dispensing equal amounts of DHA composition and amino acid composition from their respective compartments of the multi-compartment container *onto the human skin*, mixing the phases together and rubbing the resulting mixture into skin. See Abstract; col. 8, lines 31-36. Therefore, the step of mixing the phases together takes place on the skin.

14. With respect to the Weber et al. reference, the Applicant argues that there is “no step of viewing an image of a chosen coloration or make-up design before application of the treatment products and on a support such as the screen 5 of the invention.” See p. 8 of the remarks. In response, Weber et al. explicitly teach that the “subject-user can select any image that can be stored in the computer.” See col. 7, lines 5-10. How can the user select an image stored in the computer without viewing it first on the computer screen? Therefore, the reference teaches the claimed step of viewing the design before the application.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to

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37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mondays, Wednesdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached at (571) 272-0602.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER